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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,851	10/03/2003	Rainer Timpe	100584.52708US	5133

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EXAMINER

BUI, LUAN KIM

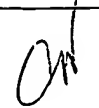
ART UNIT PAPER NUMBER

3728

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

Office Action Summary	Application No. 10/677,851	Applicant(s) TIMPE ET AL. 	
	Examiner Luan K Bui	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/3/03</u> . | 6) <input type="checkbox"/> Other: ____. |

Drawings

1. The drawings are objected to because the sectional views A-A in Figure 2 should be designated by Arabic or Roman numerals corresponding to the view number of the sectional view (MPEP 608.02(h)(3)). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "the base plate" in claims 1 and 3 lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Gottlieb (5,655,656). Gottlieb discloses a protective case (14) for a disc-shaped data carrier comprising a bottom panel (46) and a top panel (44) defining a holding space delimited by lateral walls (36,

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47, 49, 74, 76) to accommodate the data carrier, an end face of the protective case having an insertion slot (Figure 4) for inserting the data carrier into or removing the data carrier from the holding space and the lateral walls comprises guides (50, 74, 76) for supporting the data carrier spaced a distance from the bottom panel of the protective case. The top panel having a cut-out (42) for gripping the data carrier and the guides having interruptions (both sides of 62) in an area just behind the edge of the insertion slot in the lateral walls which delimit the insertion slot on both sides and the interruptions providing access for insertion of an insert into a space between the guides and the bottom panel (Figures 3-4). As to claims 6 and 7, Gottlieb discloses means (12) for closure of the insertion slot and the closure means comprise a slipcase (12).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gottlieb (5,655,656) in view of Ikebe et al. (5,385,235; hereinafter Ikebe'235). Gottlieb discloses the protective case (14) for a disc-shaped data carrier as above having all of the limitations of the claims except for at least one resilient tongue being provided in at least one guide for exerting a clamping action on the data carrier. Ikebe'235 shows a protective case (1, 2) comprising at least one resilient tongue (4, 9) with each tongue disposed in a guide for exerting a clamping action on a data carrier (Figure 7). It would have been obvious to one having ordinary skill in the art in

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view of Ikebe'235 to modify the protective case of Gottlieb so the protective case includes at least one resilient tongue provided in at least one guide for exerting a clamping action on the data carrier for better protecting the data carrier.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gottlieb (5,655,656) in view of Collins (6,494,319). Gottlieb discloses the protective case (14) for a disc-shaped data carrier as above having all of the limitation of the claim except for the closure means comprise a folding cover affixed to the protective case. Collins teaches a protective case (1, 2) having an insertion slot and a folding cover (28) attached to the case for closing the insertion slot (Figure 4). It would have been obvious to one having ordinary skill in the art in view of Collins to modify the protective case of Gottlieb so the closure means comprise a folding cover attached to the protective case for closing the insertion slot to prevent the data carrier from falling off.

Allowable Subject Matter

9. Claim3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

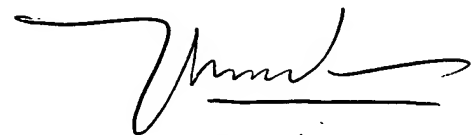
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (571) 272-4552. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Ms. Marilyn Watts at (571) 272-4398.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service whose telephone number is (703) 306-5648. Facsimile correspondence for this application should be sent to (703) 872-9306 for Formal papers and After Final communications.

lkb
December 21, 2004

A handwritten signature in black ink, appearing to read 'Luan K. Bui', with a horizontal line underneath.

Luan K. Bui
Primary Examiner